

BEST AVAILABLE COPY**REMARKS**

Entry of the foregoing amendment will not introduce new matter into the present application for invention. Therefore, the Applicant, respectfully, requests that the above amendment be entered in and that the claims to the present application be, kindly, reconsidered.

The Office Action dated December 11, 2003 has been received and considered by the Applicants. Claims 1-17 are pending in the present application for invention. Claims 1-16 stand rejected by the December 11, 2003 Office Action. Claim 17 is objected to by the December 11, 2003 Office Action.

The drawings are objected to because Figure 2 lacks descriptive labels on elements 21, 22, and 25. Redlined drawings of Figure 2 are submitted with this response that correct the reference signs mentioned by the Examiner in the Office Action.

The Office Action objects to Claim 17 under the provisions of 35 U.S.C. §1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Examiner states that Claim 17 is drawn to a recording device and is improperly dependent on Claim 16, drawn to a method. The Examiner further claims that specifying a "control unit" as carrying out a method does not recite what are the actual functions of the "control unit" and states that Claim 17 is otherwise not considered on the merits. The Applicants would like to, respectfully, point out that the Examiner is required to examine Claim 17 on its merits. The MPEP § 2173.05(f) specifically states that it is proper to make reference to a preceding claim limitation and should not be rejected for that reason. In the present case, the Examiner objects to Claim 17 because it is alleged that Claims 17 does not further limit Claim 16. The Applicants, disagree. The additional limitation of a controller being configured to perform the method of Claim 16 does further limit Claim 16. Therefore, the Applicant decline to amend Claim 17 in view of this objection because the Examiner has provided no basis for this requirement.

The Office Action rejects Claims 1-16 under the provisions of 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The

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Examiner states that base Claims 1 and 13 are method claims lacking positively recite method steps, rather the claims merely recite desired results. The foregoing amendment to Claims 1 and 13 has corrected this oversight. However, the Applicants would like to, respectfully, point out that Claims 5, 8, 9 and 11 are also independent claims that positively recite method steps. Accordingly, this rejection regarding Claims 5, 8, 9, and 11, and the claims that depend therefrom is, respectfully, traversed. The Applicants, respectfully, submit that, after entry of the foregoing amendment, each of Claims 1-16 set forth method steps that clearly indicate the process that the Applicants are intending to encompass.

The Office Action rejects Claims 1-16 under the provisions of 35 U.S.C. §101 stating that the rejected claims recite a use, without setting forth any steps involved in the process, resulting in an improper definition of a process. The foregoing amendment to Claims 1 and 13 has included steps involved in the process of the invention to correct this oversight. The Applicants would like to, respectfully, point out that Claims 5, 8, 9 and 11 are independent claims that already positively set forth process steps. Accordingly, this rejection is, respectfully, traversed regarding Claims 5, 8, 9, and 11, and the claims that depend therefrom. The Applicants, respectfully, submit that after entry of the foregoing amendment, Claims 1-16, set forth method steps that clearly indicate the process that the Applicants are intending to encompass.

The Office Action rejects Claims 3-12 and 15-16 under the provisions of 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. The Examiner states that a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation is considered indefinite, since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired. The Applicants would like to, respectfully, point out that rejected Claim 3 recites a method wherein the tracking signal has a nominal signal value of zero corresponding to the center of a track, a maximum value corresponding to a maximum lateral deviation with respect to the center of a track, and wherein preselected fraction of the maximum value is chosen as a signal threshold. Prior the foregoing amendment, the fraction was stated as preferably being 0.5 or one half. The Applicants do not concur that this results in a recitation of a narrow range within a

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broad range being recited by rejected Claim 3 as the Examiner asserts. However, in an effort to move this case towards allowance, Claim 3 has been amended to remove the recitation of 0.5. The Applicants would like to, respectfully, point out that the amendment to Claim 3 is a broadening amendment and as such does not restrict the application of the Doctrine of Equivalents to the amended version of Claim 3. Claim 4 has been amended by the foregoing amendment to remove any potential ambiguity regarding the claimed subject matter. The Applicants would like to, respectfully, point out that the amendment to Claim 4 is a broadening amendment and as such does not restrict the application of the Doctrine of Equivalents to the amended version of Claim 4.

The Examiner states that rejected Claims 5 and 9 contain the broad recitation "examining the integrity" and also recite "preferably by means of a method as claimed in Claim 1" which is a narrower statement of the range limitation. The Applicants respectfully submit that the recitation "examining the integrity" is a more narrow statement than "examining a recording track". Therefore, the foregoing amendment to the claims has essentially rearranged Claims 5 and 9 to make it more clear that they further narrow and define Claim 1. The Applicants would like to, respectfully, point out that the foregoing amendment to Claims 5 and 9 tend to broaden and as such do not restrict the application of the Doctrine of Equivalents to the amended version of Claims 5 and 9.

The Examiner further states that Claims 8, 11 and 15 recite terminology constituting a more narrow range within a broader range. This has been corrected by the foregoing amendment to the claims. The Applicant would like to, respectfully, point out that the amendment to Claims 8, 11 and 15 is a broadening amendment and as such does not restrict the application of the Doctrine of Equivalents to the amended version of Claims 8, 11 and 15.

The Office Action rejects Claims 4 and 16 under the provisions of 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner states that the claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner further states that the specification does not disclose information regarding the numerical range of the "predetermined period of time" described in Claims 4 and 16. The foregoing amendment to the specification has corrected his oversight by modifying the paragraph within the specification on page 12, beginning on line

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14 with the language within Claims 4 and 16 that the Examiner has stated does not exist within the specification. This language was contained within the claims as originally filed, therefore, the addition of this language to specification does not result in the addition of new matter to the present application for invention. The Applicants would like to, respectfully, point out that the foregoing amendment to Claims 4 and 16 tend to broaden and as such do not restrict the application of the Doctrine of Equivalents to the amended version of Claims 4 and 16.

The Office Action rejects Claims 1-4 and 13-16 under the provisions of 35 U.S.C. §102(b) as anticipated by Takasago, et al. (hereinafter referred to as Takasago). The Examiner states that Takasago discloses in FIG. 3 of that the nominal tracking signal value is 0.5 of the maximum value. The Applicants respectfully disagree with this assertion contained within the Office Action. FIG. 3 of Takasago discloses a pair of reference voltages that are placed into a comparator to indicate when the tracking signal has digressed from the intended path of the amount shown by these reference voltages (see column 5, lines 47-63). There is no disclosure, or suggestion, within Takasago for a nominal tracking signal that is approximately one-half of the maximum value. Furthermore, Takasago does not teach a signal value exceeding a predetermined threshold for a predetermined time period as recited by the rejected claims. Additionally, there is no fraction of a maximum value that is taught by Takasago. Accordingly this rejection is, respectfully, traversed.

The Office Action rejects Claims 1, 5, 6, 9, and 10 under the provisions of 35 U.S.C. §102(b) as being anticipated by Tsuchiya, et al. (hereinafter referred to as Tsuchiya). The Examiner states that Tsuchiya discloses all the elements of the rejected claims. The Applicants, respectfully, disagree. Tsuchiya does not disclose, or suggest, rating the examined recording track based on the characteristics of the tracking signal as recited by rejected Claim 1 to the present invention. Furthermore, Tsuchiya does not disclose teach that the number of defective tracks needs to be greater than predetermined threshold as recited by rejected Claim 5 to the present invention. Tsuchiya does not disclose any alarm list as recited by rejected Claim 9 to the present invention. Rejected Claim 10 depends from Claim 9, which is believed to be allowable, therefore, Claim 10 is believed to be allowable. Accordingly this rejection is, respectfully, traversed.

The Office Action rejects Claims 1 and 5-10 under the provisions of 35 U.S.C. §102(c) as being anticipated by Sasaki, et al. (hereinafter referred to as Sasaki). The Examiner

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states that column 6, lines 12-50 and column 7, line 22 through column 8, line 13 of Sasaki disclose recording and testing tracks for defects, rating the recording track based on the tracking signal, examining tracts, examining adjacent tracts, establishing the memory defect list, skipping to next tract, recording the defeat defect list on the disk and skipping defective tracks turn recording. The Applicants, respectfully, disagree with these assertions contained within the Office Action. Sasaki on column 6, lines 12-50 discusses various difficulties that can be encountered in accessing sectors on the disk. This portion of Sasaki does not discuss rating a recording track based on a tracking signal as asserted by the Office Action. Column 7, line 22 through column 8, line 13 of Sasaki discusses various embodiments wherein defective sectors that cannot be physically traced are registered within a list. This discussion involves dividing tracks into a plurality of sectors, however, there is no discussion for examining tracts, examining adjacent tracts, skipping to the next tract or skipping defective tracks turn recording as asserted by the Office Action. Accordingly this rejection is, respectfully, traversed.

The Office Action rejects Claims 7 and 8 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Tsuchiya as applied to Claim 6, and further in view of Itooya (hereinafter referred to as Itooya). As previously discussed Claim 6 is believed the allowable over the recited references. There is no disclosure, or suggestion, within the cited references for storing defective tracks analysts only when the number of adjacent tracts exceeds a predetermined threshold. Rejected Claims 7 and 8 depend from and further narrow and define Claim 6, therefore, because Claim 6 is believed to be allowable recited references, Claims 7 and 8 are also believed to be allowable oversight references. Accordingly, this rejection is respectfully, traversed.

The Office Action rejects Claims 11 and 12 under the provisions of 35 U.S.C. §112, second paragraph, and would be allowable if rewritten to overcome the rejections and to include all of the limitations of the base claim and any intervening claims. Claim 11 has been rewritten to overcome the rejections stated by the Examiner, therefore, Claims 11 and 12 are now in condition for allowance.

New Claims 18-22 have been added that recited subject matter that was formerly contained in Claims 1-17. Therefore, the addition of these claims does not result in the introduction of new matter into the present application for invention. Each of Claim 18-22 depend from, and further narrow and define claims previously discussed above. Accordingly,

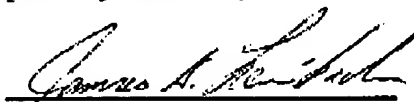
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new Claims 18-22 are believed to be allowable over the cited references.

Applicant is not aware of any additional patents, publications, or other information not previously submitted to the Patent and Trademark Office which would be required under 37 C.F.R. 1.99.

In view of the foregoing amendment and remarks, the Applicant believes that the present application is in condition for allowance, with such allowance being, respectfully, requested.

Respectfully submitted,

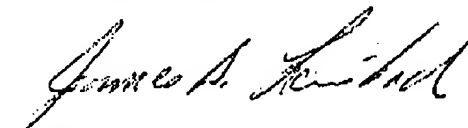
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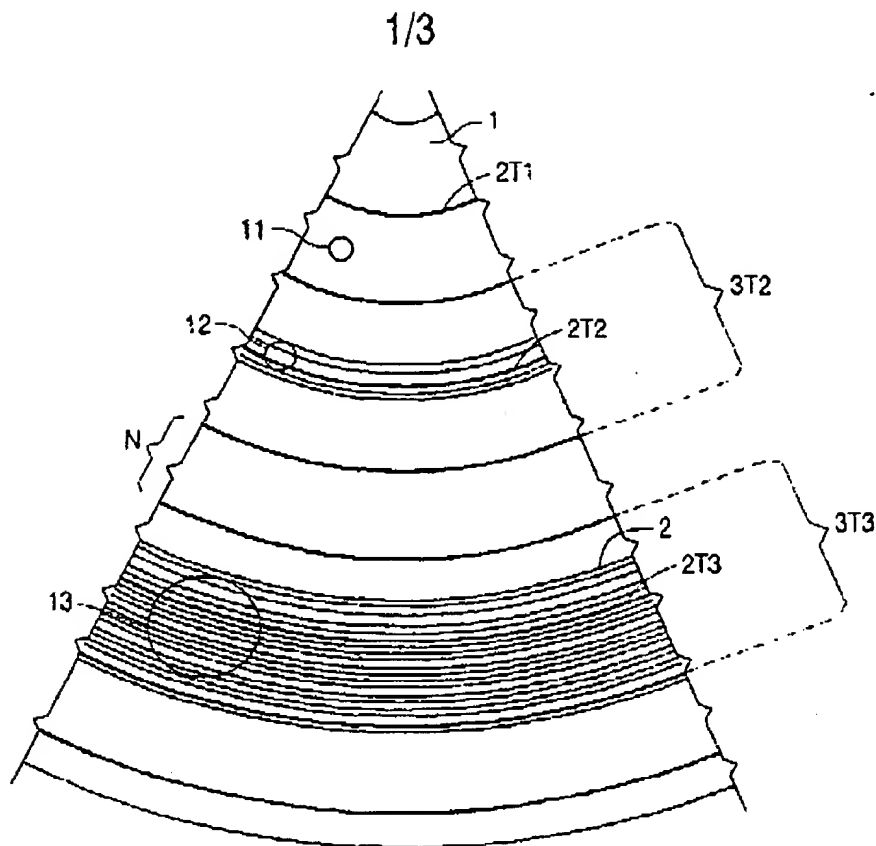


FIG. 1

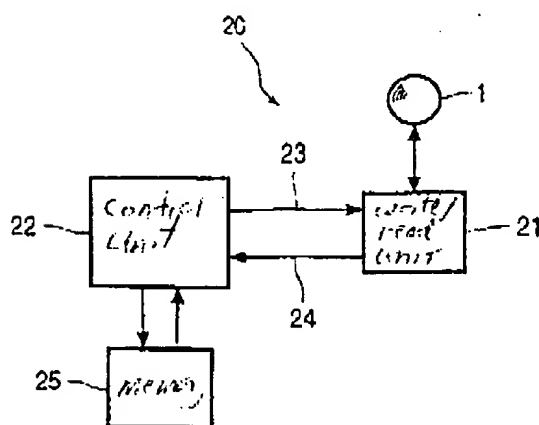


FIG. 2